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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970.

No. 1140

THE D. S. BROWN COMPANY AND
DELMONT D. BROWN,

Petitioners,

vs.

ACME HIGHWAY PRODUCTS CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

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IN THE

Supreme Court of the United States

October Term, 1970.

No. ____.

THE D. S. BROWN COMPANY AND
DELMONT D. BROWN,

Petitioners,

vs.

ACME HIGHWAY PRODUCTS CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

Petitioners, The D. S. Brown Company and Delmont D. Brown, pray that a writ of certiorari issue to review that portion of the judgment of the United States Court of Appeals for the Sixth Circuit entered in Appeal Nos. 15910 and 15952 on September 24, 1970, which judgment reversed the judgment of the District Court and held Delmont D. Brown, the above named individual Petitioner and Secretary and General Manager of the corporate Petitioner, not to be a joint inventor of the subject matter patented in the Respondent's United States Letters Patent No. 3,179,026.

CITATIONS TO OPINIONS BELOW

The opinion of the District Court is unreported. It appears at pages 57-64 of the Consolidated Joint Appendix from the appeals below. It is included in the Appendix herein. The opinion of the Court of Appeals is reported at 431 F. 2d 1074 and also at 167 USPQ 129.

JURISDICTION

The judgment of the Court of Appeals was entered on September 24, 1970. Rehearing was denied on October 19, 1970. The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1). This litigation originated as an action for patent infringement and for declaratory judgment that Delmont D. Brown was not an inventor of the patented pavement seals. Jurisdiction in the District Court was based on 35 U. S. C. § 281 and 28 U. S. C. § 1338, § 2201, and § 2202.

This petition for writ of certiorari lies under Rule 19(1)(b) of the rules of this Court in that the decision below of the Court of Appeals for the Sixth Circuit, calling for clear and convincing proof of joint inventorship, is in conflict with recent decisions of the Court of Customs and Patent Appeals which state such proofs to be sufficient on a preponderance of the evidence; and further this petition presents an important question of Federal Law which has not been, but should be, settled by this Court, *viz.* the effect upon earlier decisions of the Supreme Court and lower federal courts pertaining to joint inventorship by new, liberalized provisions of the 1952 Patent Act for amendment or correction of non-joinder of a joint inventor after the Letters Patent has been issued by the Patent Office. To Petitioners' knowl-

edge, this Court has not construed or reviewed these provisions since their enactment.

Petitioners request this Court to review the judgment of the Court of Appeals insofar as such judgment finds and holds Delmont D. Brown not to be a joint inventor of the subject matter patented in Respondent's U. S. Letters Patent No. 3,179,026. The Petitioners urge that this Court should take jurisdiction because:

(1) The Court of Appeals erred in summarily reversing the judgment of the District Court, which held Delmont D. Brown to be a co-inventor on a preponderance of the evidence, and should have reviewed all the evidence to ascertain whether it was in fact clear and convincing of Brown's joint inventorship, as your Petitioners contend it to be.

(2) The Court's ruling that clear and convincing evidence is necessary to prove joint inventorship (a) completely ignores the liberalized provisions on correction of inventorship in new Sections 116 and 256 of the 1952 Patent Act, Title 35 U. S. C., effective January 1, 1953; (b) contravenes recent decisions of the Court of Customs and Patent Appeals which have interpreted these new sections; and (c) relies upon outmoded decisions which were decided long before 1953, and are not in point on their facts.

QUESTIONS PRESENTED FOR REVIEW.

The important federal question presented herein are:

1. Should the appellate court summarily have reversed the judgment of the trial court holding that a preponderance of the evidence had established Delmont D. Brown to be a joint inventor, and rule that joint inventorship must be

proven by clear and convincing evidence without reviewing that evidence to ascertain whether it was clear and convincing or a preponderance?

2. Should the appellate court have held that clear and convincing evidence is necessary to prove joint inventorship in the face of recent holdings by the Court of Customs and Patent Appeals that a preponderance of the evidence is sufficient under the 1952 Patent Act and the liberalized provision thereof relating to correction of inventorship in Sections 116 and 256?

STATUTES INVOLVED.

U. S. Code, Title 35, Patents.[1]

The applicable section of the Patent Code are:

§ 102. Conditions for patentability; novelty and loss to right for patent:

A person shall be entitled to a patent unless

* * * * *

(f) He did not himself invent the subject matter sought to be patented, . . .

* * * * *

§ 116. Joint inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

* * * * *

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

1. Public Law 593, 82d Cong., 2d sess., ch. 950; 66 Stat. 792.

§ 256. Misjoinder of inventor

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

§ 261. Ownership; assignment:

Subject to the provisions of this title, patents shall have the attributes of personal property.

§ 262. Joint owners:

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

STATEMENT OF THE CASE

This litigation originated in the United States District Court for the Northern District of Ohio, Western Division, as an action for patent infringement and declaratory judgment that Delmont D. Brown was not an inventor of the subject matter of the patent in suit. The defendants denied infringement, asserted that the patent was invalid and further, even if valid, the patent was unenforceable against the defendants because of inventorship by Brown. The District Court held the patent to be invalid (Appendix A herein) and further held that the patent was unenforceable against the defendants because, on a preponderance of the evidence, the Court found Delmont D. Brown to be a co-inventor.

The Court of Appeals for the Sixth Circuit reversed the decision of the lower Court and held the patent to be valid. It further dismissed summarily the holding of co-inventorship by the lower Court on the ground that Brown's claim of co-inventorship must as a matter of law be proven by clear and convincing evidence, instead of a preponderance of the evidence (Appendix B herein). A Petition for Rehearing filed by Brown was denied (Appendix C herein).

The subject matter of the Respondent's patent concerns pavement seals which are mounted in a laterally compressed state in transverse joints of concrete highways. The seal is a preformed strip of low crystallization neoprene. It has planar side walls, a V-shaped top wall, a V shaped bottom wall and internal webs consisting of a lower pair of crossed webs and an upper pair of inverted V webs defining two diamond cavities and four triangular cavities. The geometry of the seal is illustrated in the opinion of the Court of Appeals at 431 F. 2d 1081 (p. A19).

The joints into which the seal is inserted are spaces between concrete pavement slabs which expand and con-

tract. In warm weather, as the concrete expands, the joints close. In cold weather, when the concrete contracts, the joints open. The patented sealing strips remain pressed against the opposed faces of the joints to seal out intrusion into the joints of liquids and solids, e.g., water, sand, pebbles, etc.

The Petitioners and Respondent worked together in the spring of 1960 in the design of a series of seals which led to the geometry of the patented seal. The inventorship issue revolves about whether or not Delmont D. Brown contributed during this period to the ultimate geometry in a manner wherein, under law, he is deemed to be a co-inventor.

The principals involved are the patentee, Alfred F. Crone, President of the Respondent, Acme Highway Products Corporation, Acme's Vice President, Fred F. Bryan, and Delmont D. Brown.

The patented seal has two diamond shaped cavities and four triangular cavities. Crone and Acme contended at trial and on appeal that Crone alone had conceived the entire patented geometry and that Bryan, following Crone's oral directions, had sketched Crone's conception prior to Brown's being contacted by Bryan to be Acme's supplier of pavement seals. In the spring of 1960, Brown extruded a series of neoprene seals before Brown and Acme arrived at the patented geometry, i.e., first a two diamond cavity seal found to be too stiff to insert in a joint, then a two diamond cavity, two triangle cavity seal found still to be too stiff at the top portion, and finally the patented two diamond cavity, four triangle cavity seal. Brown contends that he suggested to Acme each step of the seal's evolution. The patented geometry was suggested by Brown as a sketch on a letter by him to Acme on June 11, 1960 at the time he sent to Acme the unsatisfactory two diamond, two triangle seal. This geometry was adopted, and the first installation

in highway joints was made in the fall of 1960. The District Court rejected Acme's contention of earlier sole conception by Crone and found, after careful consideration of all of the evidence, that the final design of the patented seal was the joint product of the efforts and ideas of Brown, Bryan and Crone.

REASONS FOR GRANTING THE WRIT.

A. The Evidence Was Not Reviewed.

The Court of Appeals admittedly disposed of the issue of joint inventorship "summarily," as it so stated at 431 F. 2d 1082 of the decision without reviewing whether it was in fact clear and convincing. An issue as important as this should not be disposed of summarily, and to do so is improper when the Court had before it all of the evidence relating to this issue. If the Court believed that the evidence on this issue should have been clear and convincing, and if the District Court had in fact ruled that joint inventorship was established by a preponderance of the evidence, then the Court should have reviewed the evidence and made its own determination as to what weight it should have been accorded—as the Court did on other issues involved in the appeal below.

Had the Court reviewed all of the evidence, it would have found that Acme's key witness, Bryan, himself completely discredited his and Crone's stories about Crone's alleged conceptions of the seal geometry prior to Brown's activity in the evolution of the seal from the first double diamond cavity seal to that sketched on Brown's letter of June 11, 1960, to Acme.

B. Conflict With Recent Decision of the Court of Customs and Patent Appeals and the 1952 Patent Act.

In a recent case involving disagreement between inventors as to a critical element of conception of the invention, the C. C. P. A. held in *In re Application of Searles*, 422 F. 2d 431 (1970) that a preponderance of the evidence is enough to prove joint inventorship, stating at page 437:

> "Even absent a specific allegation of joint invention, it would be enough if the preponderance of the evidence submitted pointed in the direction of joint inventorship, so long as the existence of error without deceptive intention is satisfactorily demonstrated."

Before the enactment of the 1952 Patent Act, the misjoinder or nonjoinder of joint inventors could not be corrected, and a patent issued to one inventor on a joint invention or one issued to joint inventors for a sole invention was invalid. Understandably, the seriousness of such a situation required a relatively high degree of proof that a patented invention was sole or joint. Since 1953 this has not been the law.

Sections 116 and 256 of Title 35 U. S. C., which became effective January 1, 1953, are companion sections. Section 116 permits pending patent applications to be amended by removing a person erroneously joined as a co-inventor or by adding a joint inventor erroneously omitted without any deceptive intention on his part. Section 256 permits the same corrections in an issued patent. This section also specifically provides that the misjoinder or nonjoinder of joint inventors shall not invalidate a patent if such error can be corrected as provided for therein. The Statute further specifically empowers a Court to order such correction on notice and hearing of all parties. Since 1953 a sole patentee of a joint invention does not lose his rights when another is found to be a joint inventor.

Every one of the cases relied upon by the Court of Appeals as supporting its position that joint inventorship must be proven by clear and convincing evidence was decided long prior to the existence of the 1952 Patent Act. In addition, every one of those cases cited at 431 F. 2d 1083 of the Court's opinion is distinguishable from the present case on the facts, and all but one do not involve a joint inventorship issue.

The question of joint inventorship was not involved in *Agawam Company* v. *Jordan*, 7 Wall. 583 (1868); *Eibel Process Company* v. *Minnesota & Ontario Paper Company*, 261 U. S. 45 (1923); *The Barbed Wire Patent*, 143 U. S. 275 (1891) and *Loom Company* v. *Higgins*, 105 U. S. 580 (1881). In *Pointer* v. *Six Wheel Corporation*, 177 F. 2d 153 (C. A. 9, 1949), the defense was invalidity because a third party was not named a joint inventor. Under the 1952 Patent Act, the error, heretofore fatal to the patents' validity, could be corrected by order of the Court. 35 U. S. C. § 256.

In *Deller's Walker on Patents*, §§ 39-43 (2d ed. 1964), the cases cited therein were all premised on the law as it was prior to the enactment of Sections 116 and 256 (effective January 1, 1953). Deller does not even discuss these new sections of the patent law. Its status as an up to date text on joint inventorship is most dubious.

Any presumption of law that Crone was the sole inventor arose only from his unilateral action in signing and causing to be filed his patent applications. The Patent Office had no information about, and hence could not consider, the evidence introduced in the trial below as to Brown's co-inventorship. It therefore follows, that the trial Court's ruling of co-inventorship by Brown, based on a preponderance of the evidence, was the correct standard of proof in an issue never before the Patent Office, particularly in an area where the Congressional intent relative to correct-

ing misjoinder and non-joinder of inventors under 35 U. S. C. 116 and 256 was one of liberalizing or remedying the earlier, harsher standard of patent invalidity for non-joinder of a co-inventor.

The Court of Customs and Patent Appeals has commented in several decisions on the liberalizing intent of 35 U. S. C. 116 and 35 U. S. C. 256 on non-joinder or misjoinder of inventors and its effect on proof of joint inventorship. In *Patterson and Lissner* v. *Hauck*, 341 F. 2d 131, 138 (1965), the Court stated that these sections were added to the law

> ". . . for the purpose of removing technical grounds for attacking the validity of patents by reason of the erroneous naming of inventors, on which point the prior law was very strict. As such a liberalizing provision it should be given a liberal construction in favor of applicants, permitting them to make such changes as more thorough consideration of facts may show to be necessary in order to comply accurately with the law in naming inventors."

At 293 F. 2d 274, 279, the C. C. P. A. in *In re Application of Schmidt* (1961) stated

> "It is, we believe, the correct interpretation of congressional intent that the expression 'error * * * without any deceptive intention' in section 116 was intended not only to replace the more cumbersome expression 'inadvertence, accident or mistake' previously used but was intended to relieve applicants from the narrow application of the old terms as the courts had construed them. Every indicator of legislative intent points in that direction."

CONCLUSION.

Your Petitioners find themselves in the perplexing position in the present posture of this litigation of being accused infringers of a patent taken out by the Respondent, with whom they worked intimately and cooperatively in the step-by-step conception and ultimate realization of the geometry of the patented seal. The District Court applied the proper rule of law that joint inventorship is proven by a preponderance of the evidence and that, with Delmont D. Brown as a joint inventor, the patent is unenforceable against a joint inventor and owner of the patent. 35 U. S. C. 262. The Court of Appeals erred in reversing this judgment summarily and also in its ruling that joint inventorship must be proven by clear and convincing evidence. With Brown as a joint inventor, the patent can be amended to show such joint inventorship by order of the District Court to the Commissioner of Patents under the provisions of 35 U. S. C. 256, second and third paragraphs.

For the reasons stated, it is submitted that this petition for a writ of certiorari is well founded in fact and in law and should be granted.

Respectfully submitted,

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APPENDIX A.

The Opinion of the District Court, Issued June 6, 1969.

IN THE UNITED STATES DISTRICT COURT
For the Northern District of Ohio
Western Division.

* * * * *

YOUNG, *J.*

This action, which was originally commenced April 29, 1966, is for alleged infringement by the defendants of United States Letters Patent No. 3,179,026 entitled "Sealing Element for Pavement Grooves" which was issued to Alfred F. Crone, President of the plaintiff corporation, on April 20, 1965, and for other relief. An answer and cross-petition was filed by defendants, alleging among other things that the patent was invalid for numerous reasons; that the invention had been in public use for more than a year before the application for the patent in suit was filed; that the defendant Delmont D. Brown was a co-inventor of the patented device, and thus entitled to make full use of it; that by concealing the fact of the defendant Brown's co-inventorship the plaintiff's President Crone was guilty of a fraud upon the Patent Office; and that plaintiff's use of the fraudulently obtained patent was in violation of the anti-trust laws, and entitled defendants to recover damages. Plaintiff filed a reply to defendants' answer and cross-petition.

After much discovery and other preliminary maneuverings, amended pleadings were filed, and the matter ul-

timately was heard by the Court upon the evidence relating to all issues except damages. The matter of damages was by agreement of the parties reserved until the Court should have determined the other issues. The hearing consumed many days of time, and a large number of exhibits were offered and received in evidence.

In its ultimate posture, the evidence showed that the plaintiff is a manufacturer and seller of devices for highway pavements, including expansion joints for highways and bridges. In this field, for many years, the problem of sealing these joints to prevent them from becoming clogged, corroded, and otherwise inoperable has been a source of much difficulty and expense. Late in 1959 or early in 1960 the plaintiff turned its attention to the creation of some sort of a plastic or rubber device for sealing the joints, which was hardly an original idea, and was ultimately referred to the defendants, who were engaged in the compounding and extruding of rubber and plastics, for assistance with the project.

In the spring and summer of 1960, the parties commenced to work together to develop a neoprene joint seal. Their efforts culminated in the late fall of that year when, along with a large number of other concerns and individuals, they made experimental installations of joint seals in New York. Their seal alone was successful, some of the original experimental installations still being in working condition at the time of trial, an accomplishment hitherto unheard of.

On May 4, 1961, plaintiff's President, Crone, filed an application for a patent on the joint seal and method for installing it. This application was ultimately abandoned, some time after the application for the patent in suit was filed by Mr. Crone on June 5, 1964.

In the meantime, between the two applications, the de-

fendants manufactured, and the plaintiff sold and installed, large quantities of the joint seals in highways being publicly constructed and used in various areas. Finally, about in 1963, the parties fell into serious disagreements. The plaintiff sought and found other manufacturers for the seals, while the defendants continued to manufacture the seals and sold them on their own. Thereafter this action was commenced.

The first problem presented is whether or not the patent in suit dates back to the filing date of the abandoned application of May 4, 1961, under the provisions of 35 U.S.C. § 120, for if it does not, then it is clear that the invention had been in public use for much more than a year prior to the application on June 5, 1954, and the patent is invalid.

The defendants contend that there are four features of the patent claims which are not found in the first filed application and thus are "not common to said earlier application:"

(1) Low crystallization elastomer material—claims 1-3 and 5-8;

(2) Low crystallization neoprene synthetic rubber—claim 4;

(3) A top wall comprising two downwardly inclined wall sections which are straight and each of which is thicker than the rib members; also straight wall sections which will deflect downwardly with minimum upward bulge when the side walls are compressed laterally—claims 2, 6 and 8; and

(4) Crossed diagonal support members or ribs of the internal truss structure making an angle of 30° with the side walls—claims 5-8

The plaintiff, of course, asserts that all of these matters are actually found in the first application in common with the second.

It is not easy to sort out from the mass of evidence and

conflicting testimony what the true situation is with respect to these matters. However, the Court is satisfied that taking the whole of the evidence, there are two matters which are vital to the claims of the application for the patent in suit which are not common to the claims of the earlier application.

The first of these has to do with the structure of the seal. Claims 2, 6 and 8(c) of the patent in suit provides for a top wall comprised of two downwardly inclined straight wall sections which meet and are joined at their lower ends to form a central apex, said sections being thicker than the rib sections, so that they will deflect downward with minimum upward bulge when the sidewalls are compressed laterally. Claims 5(b) and 8(b) of the patent in suit provide for a pair of diagonal support ribs disposed within the body which converge and join at their upper ends with a central point of the top wall.

In the abandoned application of May 4, 1961, claim 9 makes the only reference to these matters in the following language:

> "* * * including a top wall connecting the opposite side walls and a pair of webs inclined with reference to said side walls and terminating at their upper ends at said top wall and integral with said side walls and top wall."

The evidence as a whole makes it clear that the two section thicker top wall, with the downward inclination which formed a central apex, and the joining of the diagonal support ribs to the central point of the top wall is essential to the utility and validity of the patent. Those claims are certainly not included in the earlier application in which the top was merely another part of the seal, and the webs were merely joined to and integral with the top wall.

The second of the two matters has to do with the composition of the seal. The claims of the patent in suit refer specifically to "low crystallization elastomeric material" in several places, and claim 4 covers a sealing strip made of "neoprene synthetic rubber." The earlier application refers to the seal being made of "an extruded elastomer", or "neoprene or a mixture of neoprene with other materials * * *".

The evidence in the record indicates that the applicant, Crane, knew little about rubber compounds or neoprene at the time of May 4, 1961 application, but did learn about "low crystallization elastomers" in the interval between the applications. In the patent in suit it is recited (Col. 4, lines 44-46) that it is essential to use a low crystallization type elastomeric material to make the strip work successfully. The greater weight of the evidence shows that the composition of the seal is at least as important as, if not more important than, the exact configuration of the cross-section of the seal.

While the plaintiff contends that this matter of composition is included by implication in the first application, and that it did not need to be set forth even in as specific a manner as it was in the second application, since anyone skilled in the art of compounding would know exactly what was needed merely from the broad language of the first application, the expert testimony was very conflicting on this point, and the weight of the expert testimony, backed up by the other evidence in this case, shows that it is doubtful whether even the description of the material in the second application is sufficient to enable a person skilled in the art to go right out and make a workable joint seal after reading the patent.

It is therefore the conclusion of the Court that the plaintiff is not entitled to the advantage of the original

filing date, because the essential claims of the patent were not included in the claims of the original application.[1] Hence, the public use of the alleged invention for a period of considerably more than a year before the application for the patent in suit destroys the validity of the patent, and the defendants are entitled to judgment in their favor in the action for infringement.[2]

There are, however, some other matters involved, and other claims and defenses made, which merit or require some consideration.

The defendant D. S. Brown contends that if the patent in suit is valid, he is actually a co-inventor with Mr. Crone, the plaintiff's President. The evidence which was adduced on this point was in square conflict, and in its essentials, ultimately comes to a determination of the credibility of witnesses, principally the defendant D. S. Brown, as against the plaintiff's Vice-President, Freel Bryant, and President, Alfred F. Crone. There was considerable documentary evidence offered both to support and contradict the testimony of these witnesses, but the probative value of some of the documentary evidence is open to large questions. A good deal of it was of a type that could easily be manufactured or altered to meet the necessities of proof, so much so that probably even an expert examiner of questioned documents would be unable to say whether it was genuine or tailored to the occasion.

This Court, of course, had the advantage of having the

1. *Hazeltine Research, Inc.* v. *Zenith Radio Corp.*, 239 F. Supp. 51 (N. D. Ill. 1965), *rev'd other grounds*, 388 F. 2d (7th Cir. 1967) reversed in part, affirmed in part, 37 L. W. 4424 (U. S. Sup. Ct. May 19, 1969); *Application of Fried*, 312 F. 2d 930 (C. C. P. A. 1963); *Application of Moreton*, 312 F. 2d 954 (C. C. P. A. 1963).

2. *Tool Research & Engineering Corp.* v. *Honcor Corp.*, 367 F. 2d 449 (9th Cir. 1966), *cert. denied*, 387 U. S. 919 (1967); *Kochring Co.* v. *National Automatic Tool Co.*, 362 F. 2d 100 (7th Cir. 1966). See *FMC Corp.* v. *F. E. Myers & Bros. Co.*, 384 F. 2d 4 (6th Cir. 1967), *cert. denied*, 390 U. S. 980 (1968).

witnesses before it, and saw and heard them as they testified. The documents, also, have been carefully examined, reviewed, and weighed in the context of all the evidence. The preponderance of the evidence leads to the conclusion that the final design of the highway seal was the joint product of the efforts and ideas of D. S. Brown, Freel Bryant, and Alfred S. Crone, and that Brown must be considered as a co-inventor of the patented seal.

Actually, the evidence leads one to the conclusion, in spite of the considerable volume of expert testimony about truss structure and the effects of lateral compression, that the ultimate design was probably more the result of the practicalities of compounding material and making dies for the successful extrusion of usable strips than anything else. All of the compounding and die making was done under the direction of D. S. Brown. Neither Crone nor Bryant had any knowledge or experience in this area.

This conclusion reinforces the Court's determination that the plaintiff has no right of action for infringement against the defendants, since a co-inventor has the right to make full use of the invention in the absence of any agreement forbidding it, and the evidence is clear that there was no such agreement here.[3] However, it does not go to the extent of demonstrating that the plaintiff had perpetrated a fraud upon the Patent Office in procuring the patent in suit, so that the defendants are entitled to relief under the anti-trust laws.

In general, to establish actionable fraud requires proof by clear and convincing evidence that the party charged was guilty of the fraudulent conduct alleged.[4] While this

3. 35 U. S. C. § 115.

4. *Borowicz* v. *Chicago Mastic Co.*, 367 F. 2d 751 (7th Cir. 1966); *Huszar* v. *Cincinnati Chemical Works*, 172 F. 2d 6 (6th Cir. 1949).

Court finds that a preponderance of the evidence establishes the credibility of the defendant D. S. Brown's version of the disputed facts, and casts doubts upon the testimony and exhibits that conflict with it, this is far from saying that the evidence is clear and convincing about either side's version of these matters. Nor does it necessarily require a finding of bad faith upon the part of Crone, who signed the application for the patents. He relied upon evidence which the Court concludes is unreliable, but was not necessarily responsible for its unreliability. Nobody involved in the case stands out as such a paragon of purity and honesty that the Court should go further than leaving the parties where it finds them, to render a judgment which approaches punishment of the unsuccessful party.

This opinion will serve as the Court's findings of fact and conclusions of law. Judgment will be rendered in favor of the defendants upon the plaintiff's amended complaint, declaring the patent invalid, and judgment will be entered in favor of the plaintiff on the amended counterclaim of the defendant D. S. Brown Company for damages. Each party shall pay his or its own costs.

Defendants may prepare an entry accordingly and submit the same within ten days from the filing of this opinion to plaintiff for approval as to form. If plaintiff does not approve the entry as drafted by defendants, it may, within ten days from receipt of defendants' entry, submit an entry to defendants for approval as to form. If defendants do not so approve, they shall immediately send both drafts of entry to the Court, which will thereupon fix an entry.

DON J. YOUNG,
United States District Judge.

Toledo, Ohio.

APPENDIX B.

The Opinion of the Court of Appeals.

ACME HIGHWAY PRODUCTS CORPORATION,
Plaintiff-Appellant Cross-Appellee,

vs.

THE D. S. BROWN COMPANY and DELMONT D. BROWN,
Defendants-Appellees Cross-Appellants.

Nos. 19910, 19952.

UNITED STATES COURT OF APPEALS,
Sixth Circuit.

Sept. 24, 1970.

Before EDWARDS, CELEBREZZE and BROOKS, *Circuit Judges.*
CELEBREZZE, *Circuit Judge.*

This is an appeal from the United States District Court for the Northern District of Ohio, Western Division, of an action instituted by Acme Highway Products Corporation ["Acme"] against the D. S. Brown Company and Mr. Delmont D. Brown, charging the latter with infringement of Acme's patent on a preformed, neoprene device for sealing expansion seams and joints in highways. Brown and the Brown Company counterclaimed charging: that the patent was invalid; that Brown was a co-inventor and therefore entitled to manufacture, use, and sell the device; that by concealing Brown's status as a co-inventor, Acme, the patentee, was guilty of fraud upon the Patent Office; that Acme's use of the patent was in violation of Section 2 of the Sherman Act, 15 U. S. C. § 2 (1964). The District Court held that the patent was invalid for more than one-

year's prior use; that, in the alternative, Brown was a co-inventor; but that the defendants had failed to prove fraud upon the Patent Office or an antitrust violation. Acme appeals; Brown and Brown Company cross appeal.

I. The Patent in Suit.

Modern highways are made of 15 to 100-foot-long concrete slabs spaced to allow for thermal expansion and contraction. The spaces between adjacent concrete slabs are called joints. In warm weather, due to expansion of the road surface, the sides of the joints are pushed together; in cold weather, the contraction of the road surface causes the sides of the joint to separate. In the absence of a joint sealing material, petroleum, brine, and other liquids enter the joint, eroding the subsurface, and causing the concrete slabs to collapse. In addition, sand, pebbles, and other incompressible debris falls into joints, inhibiting normal thermal expansion of the concrete, and causing it to erupt and crack.

Prior to introduction of the patented device, the most commonly used joint seal was a tar-based, liquid seal, poured or injected into the joint, which solidified upon curing. This seal, and similar ones made of plastics, were never satisfactory for more than one season of thermal cycling. In the heat of summer, the expanded concrete simply squeezed the sealant out of the joint. Tires of passing vehicles spread it over the highway surface. As the weather became cold, there was insufficient sealant left in the joint to fill it, the sealant became stiff, and would not adhere to the sides of the joints. Stones and incompressibles fell into the joints, and unless they were cleaned before the next warm season, the concrete ruptured where it could not expand. The cost of maintenance of highways was therefore high, and state departments of highways were anxious to find satisfactory alternatives.

In response to this need, many major manufacturers

tried many different compositions of road seals, including preformed strips (*i.e.*, molded strips) of synthetic rubbers which were inserted between the walls of the joint rather than injected as liquids. The District Court found that none of these early plastic, tar, or pre-formed rubber seals worked satisfactorily.

To perform properly, a seal had to be able to exert a substantial and continuous lateral force against the sides of the joint over several years of thermal cycling; it had to resist the downward push of stones and automobile tires; it had to prevent the seepage of liquids into the joint; and it had to withstand exposure to the elements, and resist the corrosive influences of brine, ozone, and the by-products of petroleum combustion.

The patent in suit, United States Patent No. 3,179,026, was issued on April 20, 1965 to Alfred F. Crone, president of Acme. The patent describes, in general, a pre-formed strip of low-crystallization neoprene which, in cross-section, has a six-sided wedge shape. The strip is placed into the joint, and may be glued to its side. Although hollowed out, the seal has a unique internal configuration of neoprene ribs, which translate vertical forces on the seal into lateral forces to prevent upward or downward slippage of the seal within the joint. The low crystallization material is capable of withstanding exposure not only to the elements, but also to vehicular exhaust, and it remains resilient after many seasons of thermal cycling and in cold weather. Because it exerts a substantial and continuous lateral force against the sides of the joints, the seal prevents entry of liquids and pebbles. After some early testing, the patented device was selected for use and roundly acclaimed by the highway departments of many states. All experts who testified in the District Court acclaimed the device as a significant improvement over the prior art, and the District Court described its introduction as "an accomplishment hitherto unheard of."

II. Validity.

The District Court found that Acme's and Brown's sale, manufacture, and public use of the device for more than one year prior to the application for the patent, invalidated the patent, 35 U. S. C. § 102(b) (1964).[1] Acme argues that under 35 U. S. C. § 120 (1964)[2] the patent was entitled to the filing date of a parent application which was filed prior to any public use of the device. We find that the later application, which was granted, is entitled under section 120 to the filing date of the earlier, and that the patent in suit is valid.

On May 4, 1961, Mr. Crome filed a patent application on a device for sealing highway joints, and on a method for

1. 35 U. S. C. § 102(b) provides:

> "A person shall be entitled to a patent unless . . .
> "(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

The novelty, utility, and obviousness of the Crome device are not raised as issues on this appeal; the District Court made no findings with respect to them.

2. 35 U. S. C. § 120 provides:

> "An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application."

Section 112, the first paragraph of which is incorporated by reference into section 120, provides:

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. * * *" 35 U. S. C. § 112 (1964).

installing the device. Shortly after its filing, in response to a demand by the Examiner, Crone restricted his application to the device, and, apparently, abandoned the claims relating to the method of installing it. *See* 35 U. S. C. § 116 (1964); 37 C. F. R. § 1.141, et seq. Thereafter, the application was amended four times, new claims were added, and old ones modified. On April 8, 1964, in its final posture prior to abandonment, all claims of the application had been rejected by the Examiner; however, the Examiner indicated that one of the claims, *viz.* claim 17, "may be allowed" if it were amended to include certain functions which the Examiner found to be "inherent" in the unamended claim. It is unclear from the record of proceedings in the Patent Office that is before this Court, whether the application was expressly abandoned, or whether it was permitted to lapse for want of prosecution for a six-month period. *See* 35 U. S. C. § 133 (1964); 37 C. F. R. § 1.135(a).[3]

In any event, prior to the abandonment of the parent application, on June 5, 1964, Crone filed a continuation-in-part application purporting to embody the same invention embodied in the parent. By this time, the Crone device had been on the market for more than a year. The continuation-in-part application met with greater success in the Patent Office than did its parent, and on April 20, 1965, a patent was granted upon it. The date of the patent related back to the time of filing of the parent application, *i.e.*, May 4, 1961.

It is well established that to come within the purview of section 120, a later application must: (a) disclose an invention which had previously been disclosed in the manner

3. Acme claims that the parent application was abandoned upon the advice of the Patent Examiner, in order to eliminate certain extraneous material. The reasons for the filing of the continuation-in-part, and for the abandonment of the parent are, however, irrelevant in a determination of whether the latter is entitled under section 120 to the filing date of the former.

provided in 35 U. S. C. § 112 in an earlier application; (b) be by the same inventor; (c) be filed before the abandonment of the prior application; (d) expressly refer to the prior application. 35 U. S. C. § 120 (1964). *See Bendix Corporation* v. *Balax, Inc.*, 421 F. 2d 809, 816, 817 (7th Cir. 1970); *Technicon Instruments Corporation* v. *Coleman Instruments Corporation*, 385 F. 2d 391, 393 (7th Cir. 1967) and cases cited therein. There is no dispute that, in the instant case, the second application was by the same inventor (Crone) as the first; that it was filed prior to the abandonment of the first application; that it specifically referred to the first application.

The sole issue is whether the continuation-in-part application discloses an invention which had previously been disclosed, in the manner provided by section 112, in the parent application.

The District Court held that the continuation-in-part application contained four features which were not present in the parent. Those features were considered to be:

> "(1) Low crystallization elastomer material—claims 1-3 and 5-8 [of the continuation-in-part application];
>
> (2) Low crystallization neoprene synthetic rubber—claim 4;
>
> (3) A top wall comprising two downwardly inclined wall sections which are straight and each of which is thicker than the rib members; also straight wall sections which will deflect downwardly with minimum upward bulge when the side walls are compressed laterally—claims 2, 6 and 8; and
>
> (4) Crossed diagonal support members or ribs of the internal truss structure making an angle of 30° with the side walls—claims 5-8."

In reaching this conclusion, the District Court restricted its comparison of the two applications to the *claims* of each. In other words, features contained in the *claims* of the sec-

ond which were not in the *claims* of the first were not deemed to be disclosed in the first. Thus, the District Court stated:

> "[T]here are two matters which are vital to the claims of the application for the patent in suit which are not common to the claims of the earlier application."
>
> "It is therefore the conclusion of the Court that the plaintiff is not entitled to the advantage of the original filing date, because the essential claims of the patent were not included in the claims of the original application."

In so limiting its inquiry, the District Court erred.

The inquiry required by section 120 demands a comparison not only of the claims of the parent and continuation-in-part applications, but also of any other disclosures made in the applications. Thus, a feature claimed in the second application which was not claimed in the first, but which appeared in the specification or drawings of the first, is considered to be disclosed in each. An application effects a reduction to practice of everything disclosed therein, regardless of what is claimed. *Chapman* v. *Wintroath*, 252 U. S. 126, 137, 40 S. Ct. 234, 64 L. Ed. 491 (1920); *Benedict* v. *Menninger*, 64 F. 2d 1001, 1003, 20 CCPA 1138 (1933); *Arnold* v. *Langmuir*, 36 F. 2d 834, 835, 17 CCPA 756 (1930). Had the District Court compared the total disclosures of each application, it could not have reached the result it did.

First, the District Court held that the first application did not disclose a "low crystallization elastomer material" or "low crystallization neoprene synthetic rubber." This was clear error.

After mentioning that the failure of the prior art was its inability to retain its resiliency in cold and warm

weather, the parent application stated (in its description of the invention):

> "These sealing members are preferably made of an extruded elastomer. However, it has been found that for most conditions the elastomer may be made of neoprene or a mixture of neoprene with other ingredients so that the material has a high resistance to deterioration by sunlight and materials which may be found on a pavement, such as salt, sand, calcium chloride and mineral oil. The composition of which the sealing member is made should be such that it will retain its elasticity and its ability to return to its original shape or into close resemblance thereto for a considerable number of years. Certain neoprene compounds are particularly well adapted to comply with these various requirements, but other elastomers may be employed if desired."

Mr. Crone admitted that at the time of the first application, he was not an expert in extruding neoprene or other elastomers. The disclosure above, however, makes it clear that he referred to a material capable of remaining elastic in cold or warm weather, resisting deleterious elements associated with highways, and mentioned specifically "neoprene."

Every expert who testified at the trial of this case indicated that if such a substance were described to him at the time of filing of the first application, he would have thought of a low crystallization elastomer such as neoprene. Indeed, Mr. Delmont D. Brown, himself, testified that he knew, upon first learning of the invention in 1960, that low crystallization neoprene was called for.

> "Q. Mr. Brown, did I understand your testimony correctly that you did think of low crystallization material at the outset in your initial discussions with Bryan [Acme's representative], or is your testimony that it was not considered by you as the right material for the job?

"A. You are talking about April 15, 1960?

"Q. That's right, yes, your first meeting. He said, 'I have a seal I want you to make,' and told you the characteristics of the seal. Now, at that meeting after describing the characteristics to you, did you realize, because of your experience in this field, that he would require low crystallization neoprene?

"A. I think in my own mind that I concluded we would use low crystallization neoprene. However, whether I related this to Mr. Bryan or not, I doubt it.

"Q. And this was at the first meeting?

"A. Right.

"Q. And this was based on his description of the characteristics of the seal to you?

"A. Well, no. It was based on his outlining the problem in the field and he said that the seal had to function at low temperatures to keep the salt brine and material out of the joint and I figured that, if it has got to be flexible and effect a sealing pressure against the joint face at low temperatures, it should be crystallization resistant.

"Q. Well, this was the only material one would use for a rond seal, would it not be?

"A. Well, apparently, because—

"Q. No; answer my question please. This would be the only material that a skilled person in this field would use for a rond seal, would be the low crystallization; isn't that true?

"A. It should be."

The law is clear that subject matter may be added to an application by way of amendment or by a continuation-in-part application, without impairment to the right of the original filing date, where the added subject matter is "something that might fairly be deduced from the original application." *Cincinnati Rubber Manufacturing Company* v. *Stowe-Woodward, Incorporated*, 111 F. 2d 239, 242 (6th Cir. 1940); *National Battery Company* v. *Richardson Company*, 63 F. 2d 289, 293 (6th Cir. 1933); *United States Pipe*

and Foundry Company v. *Woodward Iron Company*, 327 F. 2d 242, 247 (4th Cir. 1964). The evidence in this case leaves little question that a person skilled in the art of compounding and extruding elastomers, reading Crone's parent application in 1961, would have found low crystallization neoprene (or elastomer) to be inherent in its disclosures, and would not have had to undertake any independent experimentation in order to have done so.[4] See, *e.g.*, *Expanded Metal Company* v. *Bradford*, 214 U. S. 366, 29 S. Ct. 652, 53 L. Ed. 1034 (1909). The District Court's contrary finding is clearly erroneous, and is reversed.

We now turn to the second group of differences the District Court found between the parent and the continuation-in-part applications. These are in the geometry of the seal itself. Again comparing only the claims of each application, the District Court found basic differences, which he considered to be essential to the validity of the patent.

Claims 2, 6, and 8(e) of the patent in suit describe a top wall comprised of two downwardly inclined straight wall sections which meet and are joined at their lower ends to form a central apex, said sections being thicker than the rib sections, so that they will deflect downwardly with minimum upward bulge when the side walls are compressed laterally. The function performed by this configuration, which the District Court found in the first application but not in the second, was that it prevented the top wall of the seal from bulging upwardly, above the surface of the road, upon lateral compression of the seal.

---

4. On December 19, 1967, the Brown Company was granted a patent on a highway and bridge joint seal similar to the one in suit, made of a low crystallization elastomer. It is evident from the patent that the Brown Company and the Patent Office considered the mere term "elastomer" a sufficient description of the composition of the seal, for a person skilled in compounding and extruding elastomers, for that is all that appears anywhere in the patent. U. S. Pat. No. 3,358,568, Elastomer Seal Strips for Moving Joints (filed May, 1964).

We begin our inquiry with an examination of the structure of the seal as disclosed by the illustrations in the two applications. Figure A is a cross section of the seal which appears in the parent application; figure B is the continuation-in-part's illustration of a cross section of the seal; figure C shows the original seal under lateral compression; figure D shows the later seal under lateral compression.

Figure A

[A 2692]

Figure B

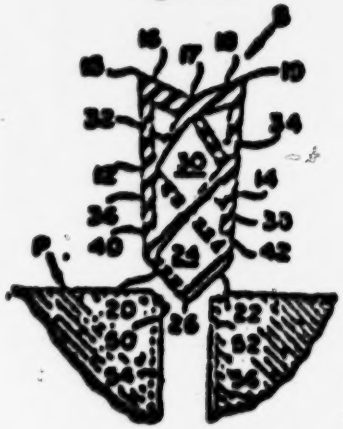
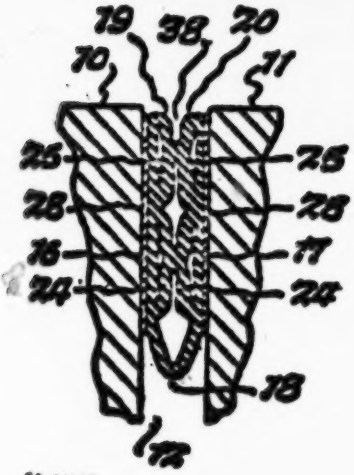
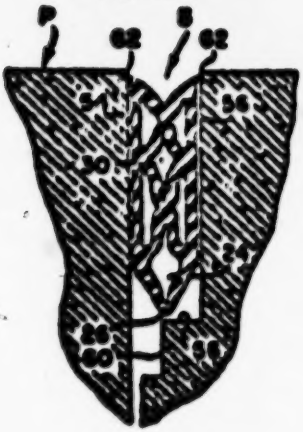


Figure C



[A 2693]

Figure D



The only apparent difference between figures A and B is the thicker top wall in figure B. The District Court held that this thicker top wall, which is claimed in the continuation in part application but not claimed in the parent application, is responsible for preventing bulge. Thus, the District Court held it a patentable difference.

A continuation in part application, by definition, contains a substantial portion or all of the earlier application plus additional, previously undisclosed, subject matter. A mere embellishment, or technical improvement, of a feature disclosed in the original application, which does not contribute to its novelty, utility, or non-obviousness, does not deprive a continuation in part application of its validity, or a patentee of the original filing date of the parent application. *See, e.g., United States Pipe and Foundry Company* v. *Woodward Iron Company*, 327 F. 2d 242, 247 (4th Cir. 1964). The Patent Office's judgment on such technical issues, *i.e.*, whether a modification is an embellishment or is of patentable importance, is entitled to special weight. *Technicon Instruments Corporation* v. *Coleman Instruments Corporation*, 385 F. 2d 391, 393 (7th Cir. 1967); *Baldwin-Lima-Hamilton Corporation* v. *Tatnall Measuring Systems Company*, 268 F. 2d 395 (3d Cir. 1959); *Helms Products* v. *Lake Shore Manufacturing Company*, 227 F. 2d 677, 679 (7th Cir. 1955).

The description of the original invention discloses a top wall which does not bulge upwardly when the side walls are compressed:

> "The sealing member 15 shown in Fig. 1 [figure A, above] is of a shape and cross section to provide maximum compression without destroying its ability to expand to its normal shape so that the sealing member will bear against the sides of the groove 12 during all of the changes in the width of the groove. ["Groove 12" and "groove" refer to the joint.] For this purpose the sealing member is provided with side walls 16 and

17 which terminate at their lower ends in a downwardly tapering V-shaped bottom wall 18 and at their upper ends in an upper wall formed in two halves 19 and 20 which converge downwardly toward each other and thus terminate in a slight depression or groove 21.

* * *

"[W]hen the sealing member is compressed, as shown in Fig. 3 [figure C, above], the diagonally extending webs 24 will collapse into the relatively large air spaces between these webs and the sides of the sealing member, and also the compression of the sealing member by the walls of the groove results in downward elongation of this member."

This description suggests that compression of the device in the parent application resulted in a "downward elongation" of the sealing member. Such downward elongation would create tension on the top wall causing it, also, to buckle downwardly. We need not rely totally on implication for this finding, however. Figure C, above, from the original application clearly illustrates it.

Furthermore, the Patent Examiner, who qualifies as one "skilled in the art," *Williams Manufacturing Company* v. *United Shoe Machinery Corporation*, 121 F. 2d 273, 277 (6th Cir. 1941), suggesting changes in wording in the parent application prior to its abandonment, found an "inward tension" on the top wall to be "inherent" in the disclosures of the parent application. Responding to the last proposed amendment to that application, he stated:

"A claim such as claim 17 when amended as follows, may be allowed. In claim 17, line 12, after the comma, insert—at least one pair of—, and cancel 'some of said.' In lines 20 and 21, cancel the portion beginning with 'at least,' and ending with 'bottom walls,' and substitute—a pair of diagonal webs being connected to said side walls above said cross webs and to approximately said longitudinal center of said upper wall—. In line 22, continue the sentence with—and inward

> tension on said center portion of said top wall to prevent bulging of said top wall—. The specification should be amended to incorporate this latter function which is considered inherent."

Thus, it was obvious to the Examiner that the original application disclosed a seal geometry having the function of preventing bulge by means of a downwardly converging top wall. That the later application specified the precise angle of the ribs to the side walls, *i.e.*, 30°, was immaterial to the Patent Office, probably because the illustrations reproduced in figures A and B, above, show those angles to be nearly identical in the parent and continuation-in-part applications.

Thus, after two sets of examinations, one in relation to the original application, and several in relation to the continuation-in-part application, the Patent Office found that the seal geometry, as opposed to the thicker wall of the later application, was responsible for preventing bulge. The Patent Office did not deem this new matter either in its examination of the parent or in its examination of the continuation-in-part application in light of the parent. Their finding was entitled to special weight, which the District Court did not accord. We find the District Court's findings of differences between the seal geometry disclosed in 1961 and 1964 to be clearly erroneous.

Upon review of the record in its entirety, we find that all claims of the Crone patent are valid, and that the patent is entitled, under 35 U. S. C. § 120 (1964) to the filing date of the parent application.

III. Joint Inventorship.

The remaining issues on appeal may be disposed of summarily. All depend upon a determination whether Brown was a joint inventor, entitled to use, manufacture, and sell

the patented device. Finding that he was not, we need not reach the issues of fraud upon the Patent Office or antitrust violations.

Upon this issue, the District Court held that a preponderance of the evidence established that Brown was a joint inventor with Crone.

> "The defendant D. S. Brown contends that if the patent in suit is valid, he is actually a co-inventor with Mr. Crone, the plaintiff's president. The evidence which was adduced on this point was in square conflict, and in its essentials, ultimately comes down to a determination of the credibility of witnesses, principally the defendant D. S. Brown, as against the plaintiff's Vice-President, Freel Bryant, and President, Alfred F. Crone. There was considerable documentary evidence offered both to support and contradict the testimony of these witnesses, but the probative value of some of the evidence is open to large questions. A good deal of it was of a type that could easily be manufactured or altered to meet the necessities of proof, so much so that probably even an expert examiner of questioned documents would be unable to say whether it was genuine or tailored to the occasion.
>
> "This Court, of course, had the advantage of having the witnesses before it, and saw and heard them as they testified. The documents, also, have been carefully examined, reviewed, and weighed in the context of all the evidence. The *preponderance of the evidence* leads to the conclusion that the final design of the highway seal was the joint product of the efforts and ideas of D. S. Brown, Freel Bryant, and Alfred S. Crone, and that Brown must be considered as a co-inventor of the patented seal." [Emphasis added.]

Further emphasizing the standard of proof he applied on the issue of joint inventorship, the District Court stated:

> "While this Court finds that a preponderance of the evidence establishes the credibility of the defendant D. S. Brown's version of the disputed facts, and casts

> doubt upon the testimony and exhibits that conflict with it, this is far from saying that the evidence is clear and convincing about either side's version of these matters."

In applying the preponderance of the evidence rule, the District Court erred.

The fact that a patent was issued in the name of Alfred F. Crone, as sole inventor, is *prima facie* proof of that fact. The burden upon Brown in making an assertion to the contrary of this presumption is very high. The temptation for honest witnesses, who have worked years with a patentee to implement his ideas, to forget whose ideas they were, is very strong. For this reason, it has been well established that joint inventorship must be proven by clear and convincing evidence. *Pointer* v. *Six Wheel Corporation*, 177 F. 2d 153, 157-158 (9th Cir. 1949), cert. denied, 339 U. S. 911, 70 S. Ct. 570, 94 L. Ed. 1338 (1950); *Agawan Company* v. *Jordan*, 7 Wall. 583, 19 L. Ed. 177 (1868); 1 Deller's Walker on Patents §§ 39-43 (2d ed. 1964). *See Eibel Process Company* v. *Minnesota & Ontario Paper Company*, 261 U. S. 45, 60, 43 S. Ct. 322, 67 L. Ed. 523 (1923); *The Barbed Wire Patent (Washburn & Moen Mfg. Co.* v. *Beat 'Em All Barbed-Wire Co.)*, 143 U. S. 275, 284-285, 12 S. Ct. 443, 36 L. Ed. 154 (1891); *Webster Loom Company* v. *Higgins*, 105 U. S. 580, 581, 26 L. Ed. 1177 (1881). Since the Appellees did not advance clear and convincing proof of joint inventorship, they did not meet their burden.

IV.

The judgment of the District Court is reversed, and this cause is remanded for proceedings consistent with this opinion. Costs on appeal are taxed against the Defendants-Appellees.

APPENDIX C.

UNITED STATES COURT OF APPEALS.

For the Sixth Circuit.

ACME HIGHWAY PRODUCTS CORPORATION, *Plaintiff-Appellant-Cross Appellee,* *vs.* THE D. S. BROWN COMPANY and DELMONT BROWN, *Defendants-Appellees-Cross Appellants.*	Nos. 19,910-19,952.

ORDER.

Before: EDWARDS, CELEBREZZE and BROOKS, *Circuit Judges.*

Upon due consideration, the petition of Appellees-Cross Appellants for rehearing is hereby denied.

It is further ordered that on page 15 of this Court's opinion filed September 24, 1970, the words "any of these matters" at the end of the quote be stricken and "either side's version of these matters" be inserted in their place.

Filed: Oct. 19, 1970.

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IN THE

Supreme Court of the United States

October Term, 1970

No. 1140

THE D. S. BROWN COMPANY and
DELMONT D. BROWN,

Petitioners,

vs.

ACME HIGHWAY PRODUCTS CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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IN THE

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Petitioners have requested this Court to grant a writ of certiorari to review that part of the order of the Court below which held that to establish the defense of co-inventorship in the accused infringer, clear and convincing evidence was required.

Statement[1]

The Sixth Circuit held that the patent upon which Respondent (Acme Highway Products Corporation) had brought this action, is valid on the ground that the invention was a significant improvement over the prior art, and in the words of the District Court, "an accomplishment hitherto unheard of." (A 11).[2]

In holding the patent valid, the Court reversed the District Court in finding the patent invalid for public use (A 22); and reversed the District Court in finding Co-Petitioner, D. S. Brown, a co-inventor based on a "preponderance of the evidence" (A 23).

In the petition, Petitioners seek review of that part of the order, specific to the burden of proof necessary to establish coinventorship in an infringer who alleges coinventorship as a defense to the action. They request this Court to decide that as a matter of law, only a preponderance of evidence be sufficient to satisfy the burden, irrespective of the equities or postures of the parties.

We respectfully submit the petition is contrary to logic, equity and *all* of the existing law as expressed by the several Circuits, and by this Court, and should be denied.

---

1. Respondent does not accept Petitioners' statements and characterization of the record, devoid of record references; but since the merits of the Petition are not affected, Respondent does not burden this Brief in Opposition by a detailed statement.

2. Reference is to the Appendix attached to the Petition.

Reasons for Opposition

Petitioners advance two arguments in support of their petition. The first is that the Court below erroneously "summarily" reversed the judgment of the trial court on the issue of inventorship; and, second, that the Court of Customs and Patent Appeals has held a preponderance of evidence sufficient, under 35 U.S.C. 116, 256, to correct a misjoinder or non-joinder of inventorship. The first argument is simply wrong, and the second is misplaced.

The Court below did not "summarily" reverse, but simply stated, after an extensive discussion of the facts and the law regarding public use, that,

> "The remaining issues on appeal may be disposed of summarily. All depend upon a determination whether Brown was a joint inventor * * *. Finding that he was not, we need not reach the issues of fraud upon the Patent Office or antitrust violations." (A 22, 23).

To place this issue in proper perspective, a brief review of the facts is necessary. The invention is directed to a resilient seal used for sealing joints in the pavements of roadways, bridges, and the like, having a unique internal configuration providing certain desirable characteristics (A 11). The seal, of course, must retain its resiliency during cold weather, and is, therefore, made of a suitable neoprene material.

The patentee, Mr. A. Crone, designed the seal, and had sketches made of his design long prior to the first meeting between Respondent and Co-Petitioner D. S. Brown. The Respondent, although in the business of manufacturing

highway products, was not an extruder of neoprene (A 16), and required the services of an extruder to produce the seal in accordance with Crone's design. Respondent obtained the name of Petitioners from the DuPont Company, manufacturer of neoprene (R 96, 97, 116-118).[1]

Prior to meeting with Respondent, Petitioners had no knowledge of road seals or their designs, or of any other highway products (R 122).

Seals embodying Crone's design were produced by Petitioners for Respondent during 1960, installed, and found to be successful. A satisfactory business relationship ensued for a time, during which Petitioners requested:

1. permission to sell seals of Crone's design, and to pay Respondent a royalty (R 143, 698); and
2. an exclusive license to sell the seal, which was denied by Respondent.

Moreover, D. S. Brown was informed of the pending patent application during the existence of the amicable relationship but never made claim to inventorship (R 149, 150).

In 1963, the parties fell into disagreements. Respondent thereafter sought and found other extruders of neoprene, and Petitioners continued to manufacture and sell Crone's design for their own profit and gain (A 3).

The patent issued to Respondent in April 1965; thereafter negotiations for a license to Petitioners failed, and this action was instituted in April 1966.

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1. Reference is to Joint Appendix constituting the record on appeal below.

Despite the fact that Respondent had sketches of the patented design prior to the meeting with Petitioners, and Petitioners admitted that they had no experience with or knowledge about road seals or other highway products prior to that meeting, Petitioners asserted the defense that D. S. Brown was a coinventor with Crone.

At trial, Respondent introduced into evidence, dated sketches, diary entries, drawings, and other documentary and live testimonial evidence. Petitioners offered only the testimony of D. S. Brown, and a single letter written by D. S. Brown to Respondent which included a sketch of the seal. The sketch was dated long after Crone's sketches, long after the meeting with Respondent, and, in fact, is mentioned in Respondent's diary[1] as a design telephonically communicated by Respondent to D. S. Brown prior to the letter. The trial court simply disregarded all the documentary evidence of Respondent on the ground that,

> "A good deal of it was of a type that could easily be manufactured or altered to meet the necessities of proof, * * *." (A 23)

The trial court held,

> "The preponderance of the evidence leads to the conclusion that the final design * * * was the joint product * * * of D. S. Brown, Freel Bryan and Alfred S. Crone * * *." (A 23)[2]

The Circuit Court reversed the trial court in applying the "preponderance of evidence" rule, in the light of the

1. The diary entries were recorded by Respondent's witness F. Bryan long prior to this action.

2. The holding that Freel Bryan was also a coinventor was utterly confounding as neither party urged such contention.

facts and the equities (A 24). The Court recognized and reiterated the well established rule as follows:

> "The temptation for honest witnesses, who have worked years with a patentee to implement his ideas, to forget whose ideas they were, is very strong. For this reason, it has been well established that joint inventorship [in the accused infringer] must be proven by clear and convincing evidence. (Pointer v. Six Wheel Corporation, 177 F.2d 153, 157-158 (9th Cir. 1949), cert. denied, 339 U.S. 911, 70 S. Ct. 570, 94 L. Ed. 1338 (1950); Agawan Company v. Jordan, 7 Wall. 583, 19. L. Ed. 177 (1868); 1 Deller's Walker on Patents §§39-43 (2d ed. 1964). See Eibel Process Company v. Minnesota & Ontario Paper Company, 261 U.S. 45, 60, 43 S. Ct. 322, 67 L. Ed. 523 (1923); The Barbed Wire Patent (Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co.), 143 U.S. 275, 284-285, 12 S. Ct. 443, 36 L. Ed. 154 (1891); Webster Loom Company v. Higgins, 105 U.S. 580, 581, 26 L. Ed. 1177 (1881). Since the Appellees did not advance clear and convincing proof of joint inventorship, they did not meet their burden."

We submit the law applied by the Circuit Court was in accord with the law earlier decreed by this Court, and uniformly applied by all the Circuits. We know of no exception, and none was cited by Petitioners.

The Court of Customs and Patent Appeals (CCPA) case cited by Petitioners in support of their second argument, *In re Searles*, 422 F.2d 431 (1970), is completely inapplicable and irrelevant. First, that case did not involve an infringer who, in his anxiety to escape liability, claimed inventorship in himself; it involved a procedural matter before the Patent Office. Searles desired to convert his patent application from sole to joint inventorship. The coin-

ventor, Lutz, and Searles filed a joint affidavit under 35 U.S.C. 116, alleging coinventorship generally. In the affidavit, however, each believed he was responsible for the suggestion of a particular material constituting one of the several elements of the invention, although both agreed that the application should be in their names jointly. The Patent Office considered the affidavit insufficient, not because of an unsatisfied burden of proof, but because of the equivocal allegation (422 F.2d 431, 434). The CCPA disagreed with the Patent Office, and held the affidavit was sufficient, primarily because both persons joined in requesting the Patent Office to convert the application from sole to joint. The fact that there was confusion as to who thought of one element in the invention, involving several elements, was not significant (422 F.2d 431, 437).

That case, therefore, is simply inapposite, and surely it is not support for the suggestion that a different rule of law is applied by the CCPA in regard to the burden on an infringer to prove the defense of inventorship in himself.

For the reasons stated, Respondent respectfully submits, that the Petition for Certiorari be denied.

Respectfully submitted,

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